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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/896,680 | 06/29/2001 | Brad A. Armstrong | 29 | 8703 |

7590 06/22/2006

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| EXAMINER |
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COBURN, CORBETT B

| ART UNIT | PAPER NUMBER |
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3714

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

1. On 1 June 2006, Applicant filed a Request for Continued Examination (RCE). Applicant did not file any amendments to the claims. Therefore, the rejection contained in the previous office action dated 1 December 2005 is incorporated herein by reference and is maintained.

Response to Arguments

2. Applicant's arguments filed 1 June 2006 have been fully considered but they are not persuasive.

3. Applicant states that Applicant and two other Examiners believe that Furakawa does not teach the present invention. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

4. Applicant's "Formal Request" that Examiner have someone competent to assist him in his examination of this case is noted – and denied. Examiner is a Primary Examiner in this art and is competent under the law to examine the instant Application. If Applicant wishes to petition for supervisory review of this action, please see 37 CFR 1.181.

5. Applicant's arguments regarding "discrete pressure buttons" were addressed in the previous office action – which see.

6. Applicant points out that Furakawa does discuss non-analog switched. However, Applicant fails to note that these switched are discussed in connection with the prior art – not Furakawa's invention. Furthermore, as pointed out in the previous office action, Furakawa specifically states that these non-analog switches are unsuited for use in video game controllers.

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In paragraph 0004, Furakawa specifically says, “Thus, the rubber contact 1 merely effects an electrical on/off operation, and **does not enable the operator to freely control**, for example, **the operation of a character in a video game.**” (Emphasis added.)

7. Furakawa’s invention is a video game controller. If Furakawa says that non-analog switches are unsuited to use in such controllers and discloses analog switches that are suited to these controllers, it is reasonable to infer that the disclosed controller makes use of these analog switches. It is unreasonable to adopt the position that Furakawa teaches use of analog switches on one side of the controller while teaching the use of unsuitable digital switches on the other side of the controller. Furakawa specifically states that the object of his invention is to solve the problem posed by use of these digital switches in a video game controller. (Paragraph 0005)

8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

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USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Furakawa teaches the claimed analog switch but does not go into the details of switch construction. Thus one of ordinary skill in the art would have been motivated to seek a prior art switch that was capable of performing the function described in Furakawa. Terajima teaches such a switch. Where a reference teaches a structure to perform a function but fails to give details as to the implementation of this structure, there is ample motivation to seek a prior art reference to teach these details.

10. Applicant argues that some of Furakawa's buttons are not discrete. Examiner points out that some are – and that having two discrete buttons meets the claimed limitations.

11. Applicant's use of the phrases "trigger keys" and "steering keys" are merely recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

12. Applicant argues that Sony's licensing of Applicant's products should be considered as evidence of secondary considerations. Applicant must surely know that "secondary considerations" do not apply to claims that are anticipated (i.e., rejected under 35 USC §102) by the prior art. Furthermore, to the extent that some claims are rejected under 35 USC §103, there was no nexus between the claimed invention and Sony's license.

13. Applicant is reminded that he may appeal this rejection by following the procedures outlined in Chapter 1200 of the M.P.E.P.

Conclusion

14. This is an RCE of applicant's earlier Application No. 09/896,680. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

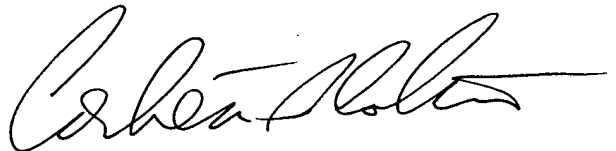
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Corbett B. Coburn
Primary Examiner
Art Unit 3714

**CORBETT B. COBURN
PRIMARY EXAMINER**